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AF 1742  
PATENT

Applicant's Docket

U 013961-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Iosif Naumovich FRIDLYANDER, et al

Serial No.: 10/089,702

Group No.: 1742

Filed: May 22, 2002

Examiner: Janell A. Combs

For: HIGHLY RESISTANT ALUMINUM-BASED ALLOY AND ARTICLE MADE FROM SAID ALLOY

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

AMENDMENT TRANSMITTAL

**WARNING:** Failure to file a complete response in compliance with § 1.135(c) leads to a reduction in patent term adjustment - See § 1.704(c)(7).

1. Transmitted herewith is an amendment for this application.

STATUS

2. The application is qualified as
- ☐ a small entity.
- ☒ other than a small entity.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\*

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37 C.F.R. 1.8(a)

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Date: October 21, 2003

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

## EXTENSION OF TERM

**NOTE:** "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

*If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).*

**NOTE:** See 37 C.F.R. §1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

**NOTE:** 37 C.F.R. § 1.704(b)". . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

*(complete (a) or (b), as applicable)*

(a) ☐ Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than <u>small entity</u>	Fee for <u>small entity</u>
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 420.00	\$ 210.00
<input type="checkbox"/>	three months	\$ 950.00	\$ 475.00
<input type="checkbox"/>	four months	\$ 1,480.00	\$ 740.00

Fee: \$ \_\_\_\_\_

If an additional extension of time is required, please consider this a petition therefor.

*(check and complete the next item, if applicable)*

☐ An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

OR

(b) ☒ Applicant believes that no extension of term is required. However, this is a conditional petition being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

## FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col. 1)	(Col. 2)	(Col. 3)		SMALL ENTITY		OTHER THAN A SMALL ENTITY	
	Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee	OR	Rate	Addit. Fee
Total	*	Minus	**	=	x \$ 9=	\$	x \$ 18=	\$
Indep.	*	Minus	***	=	x \$ 43=	\$	x \$ 86=	\$
<input type="checkbox"/> First Presentation of Multiple Dependent Claims					+ \$145=	\$	+ \$290=	\$
					Total Addit. Fee	\$ ____	OR	Total Addit. Fee \$ ____

- \* If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,  
 \*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".  
 \*\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".  
 The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

**WARNING:** "After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) ☒ No additional fee for claims is required.

**OR**

- (d) ☐ Total additional fee for claims required \$ \_\_\_\_\_

## FEE PAYMENT

5. ☐ Attached is a check in the sum of \$ \_\_\_\_\_  
☐ Charge Account No. 12-0425 the sum of \$ \_\_\_\_\_  
 A duplicate of this transmittal is attached.

## FEE DEFICIENCY

**NOTE:** *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 12-0425.

### AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 12-0425

Reg. No. 30,086

Tel. No. 212-708-1890

Customer No. 00140

  
\_\_\_\_\_  
SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(Type or print name of practitioner)

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FROM SAID ALLOY

Attorney Docket No.: U 013961-3

Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO FINAL ACTION

In response to the Official Action of October 7, 2003, Applicants submit  
herewith a Declaration under 37 CFR 1.132 executed by one of the co-inventors, Iosif  
Naumovich Fridlyander. The Declaration shows that an alloy of the invention as

**CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\***

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thereon is an oversight that can be avoided by the exercise of reasonable care, requests for  
waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed.  
Reg. 56,439, at 56,442.

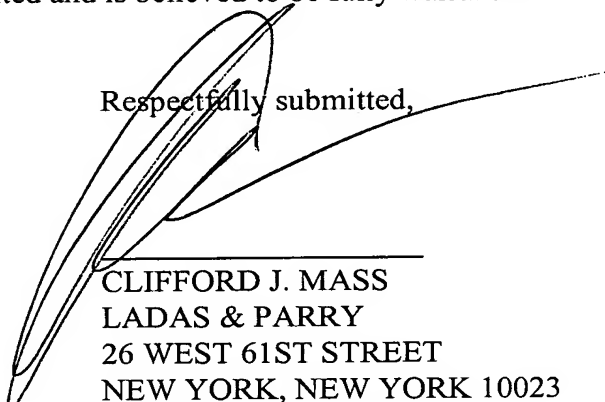
claimed, which includes beryllium within the recited amounts, provides an ingot with a higher melt fluidity and technological plasticity than does a comparable alloy of the closest prior art reference, which does not include beryllium. It is respectfully submitted that the Declaration provides evidence of unexpectedly advantageous results that would be sufficient to overcome the alleged *prima facie* case of obviousness based on the art cited in paragraphs 2 and 3 of the Official Action. This evidence is responsive to the Examiner's comments on the first full paragraph of page 5 of the Official Action.

Although it is respectfully submitted that the evidence now on file is sufficient to overcome the alleged *prima facie* case of obviousness, Applicants respectfully dispute the Examiner's contention that the cited references are sufficient to set forth a *prima facie* case. In this connection, Applicants had argued that there would have been no motivation to add Be to the Vernam et al composition in view of Brown because the relevant Vernam et al compositions are described as being closed to additional components other than impurities. The Examiner contends in the second full paragraph on page 5 of the Official Action that, at column 7, lines 27-35, Vernam et al describe an alloy as "containing" the described components and that "containing" is open claim language. However, the cited portion of Vernam et al, which is **not** a claim, expressly ends a description of the subject alloy with: "**the remainder** aluminum and impurities" (emphasis added). When considered as a whole, the reference contemplates that any components in the relevant alloys other than those expressly listed would be considered as "impurities". The reference thus does not

contemplate, and in fact teaches away from, the intentional addition of a component (such as beryllium) which is not expressly listed.

In view of the above, it is respectfully submitted that all rejections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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